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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/633,575	08/05/2003	Trent West	81876-4095	5437

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WINSTON & STRAWN  
PATENT DEPARTMENT  
1400 L STREET, N.W.  
WASHINGTON, DC 20005-3502

EXAMINER

MILLER, WILLIAM L

ART UNIT PAPER NUMBER

3677

DATE MAILED: 04/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/633,575

**Applicant(s)**

WEST, TRENT

**Examiner**

William L. Miller

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2-6 and 13 is/are allowed.
- 6) ☒ Claim(s) 1, 7-12 and 14-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 09-04;12-04;01-05.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The information disclosure statement (IDS) filed 12-10-2004 is a duplicate of the IDS filed 09-15-2004. Consequently, the references cited in the IDS filed 12-10-2004 have a line drawn therethrough as they were previously considered per the IDS filed 09-15-2004.

### ***Claim Objections***

2. Claim 8 is objected to because of the following informalities: the phrase "mirror-type" renders the scope of the claim unclear and should be changed to "mirror". Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 7-12, and 14-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lederrey (US#3242664) in view of Kousin (US#2062891).

5. Regarding claims 1, 8, 19, 20, 23, 25, and 26, Lederrey discloses a jewelry article comprising: an annular, unitary (one-piece) body 1 made of a hard material consisting essentially of a sintered tungsten carbide material and a metal (cobalt) binder (col. 1, lines 65-70), wherein the annular body has at least one external surface 2 that is in a predetermined shape (circular), a circular inner surface 9 (surface 9 furthest from surface 2 in Fig. 2), and has a polished grey mirror finish with the hard material being long wearing and virtually indestructible during

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normal use of the jewelry (see col. 5, lines 33-56), wherein a continuous portion of each of the inner and external surfaces is concentric around the circumference (periphery) of the body.

6. Although Lederrey discloses the annular body being oval-shaped as opposed to a ring (circular) as claimed by the applicant, the applicant is reminded a change in the shape of a prior art device is a design consideration within the skill of the art. In re Dailey, 357 F.2d 669, 149 USPQ 47 (CCPA 1966). In any event, Lederrey indicates the body can have various shapes (col. 5, lines 50-51), and Kousin discloses a similar jewelry article wherein the annular body thereof can be oval-shaped (Fig. 3) or a ring (circular) (Fig. 2) for aesthetic purposes. Therefore, as taught by Kousin, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Lederrey such that the annular body was a ring (circular) for aesthetic purposes.

7. Regarding claims 7, 21, and 23-27, Lederrey discloses the hard material is a sintered tungsten carbide. Lederrey does not recite any additional materials, other than the metal binder, included in the hard material. Although Lederrey fails to specifically disclose the hard material contains at least 85 weight% tungsten carbide with a density of at least 13.3g/cm<sup>3</sup>, and the binder being 3-13 weight%, it would have been obvious design choice to utilize 85 weight% tungsten carbide with a density of 13.3 g/cm<sup>3</sup>, and a binder of 3-13 weight%, as the optimization of proportions in a prior art device is a design consideration within the skill of the art. In re Reese, 290 F.2d 839, 129 USPQ 402 (CCPA 1961).

8. Regarding claim 9, Lederrey discloses an additional external surface via the curved outer side surfaces of the annular body. This additional surface will have inherently have a different

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polished finish providing unique reflection characteristics as it is spaced from and extends generally perpendicular to the external surface 2.

9. Regarding claims 10-12, 14, and 15, Lederrey discloses an annular slot defined by uppermost surface 8 which receives an insert 3 retained in the cavity via a mechanical fit (Fig.

2). The insert, namely a watch glass, is a visually different hard material.

10. Regarding claims 16, 18, and 19, Lederrey as modified discloses an annular ring (or ring) having a circular aperture (Fig. 3) “capable of” receiving a body part. Lederrey discloses at least one frusto-conically shaped surface 4 extending around the outer circumference of the ring for forming a first outer surface of the ring proximate a first axial extremity thereof.

11. Regarding claim 17, Lederrey discloses design details such as the conical shape of surface 4.

12. Regarding claim 22, the external surface of Lederrey is alternatively being viewed as the curved outer side surface of annular body.

#### ***Allowable Subject Matter***

13. Claims 2-6 and 13 are allowed.

#### ***Response to Arguments***

14. The applicant's arguments with respect to Lederrey disclosing a watch case as opposed to a ring have been considered but are moot in view of the new ground(s) of rejection.

15. The applicant argues Lederrey fails to disclose a binder material and teaches away from the inclusion thereof. The examiner disagrees as Lederrey clearly discloses in col. 1, lines 65-70, the inclusion of a metal (cobalt) binder material.

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16. The applicant argues Lederrey fails to disclose a continuous portion of each of the inner and external surfaces is concentric around the circumference of the ring. The examiner disagrees as surface 2 and lower surface 9 are continuous and concentric.

17. Regarding claims 23, 25, and 26, the applicant argues Lederrey fails to disclose a unitary ring. The examiner disagrees as Lederrey discloses a one-piece, or unitary, body 1 which is a ring (circular) when modified by Kousin. Element 12 of Lederrey, which is separate from element 1 as argued by the applicant, is not relied upon in the rejections of the claims.

18. Regarding claims 16, 18, and 19, the applicant argues Lederrey fails to disclose an aperture configured and dimensioned to receive a body part. The applicant is reminded the body part is obviously not be positively claimed and the circular aperture of the ring shown in Fig. 3 of Lederrey is "capable of" receiving a body part such as a finger.

19. Regarding claim 16, the applicant argues Lederrey fails to disclose at least one frusto-conically shaped surface extending around the outer circumference of the ring for forming a first outer surface of the ring proximate a first axial extremity thereof. The examiner disagrees as surface 4 of Lederrey meets this limitation.

20. Regarding claims 7, 21, and 23-27, the applicant fails to present any arguments specific to the design choice rejection supported by In re Reese and therefore has effectively conceded thereto.

### ***Conclusion***

21. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892. Aellen et al. (US#4706857) discloses a circular watch case 1, or ring.

Bonjour et al. (US#4574011) discloses a bracelet comprising a predominantly tungsten carbide material and a metal binder component.

22. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

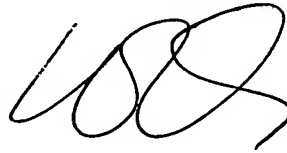
Any inquiry concerning this communication or earlier communications from the examiner should be directed to William L. Miller whose telephone number is 703 305 3978. The examiner can normally be reached on Tuesday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. J. Swann can be reached on 703 306 4115. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

William L. Miller  
Primary Examiner  
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A handwritten signature in black ink, appearing to be 'WLM', written in a cursive style.

WLM